

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: LOWLES, Robert, J.
Serial No.: 10,787,173
Filed: February 27, 2004
Title: HOLSTER FOR SUPPORTING AND CHARGING THE WIRELESS
HEADSET OF HANDHELD DEVICES
Group: 2617
Examiner: MEHRPOUR, Naghmeh
Attorney Ref.: PAT 53955-2

May 7, 2009

AMENDED APPEAL BRIEF

Mail Stop Appeal Brief-Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Notification of Non-Compliant Appeal Brief, Applicant submits the following Amended Appeal Brief pursuant to 37 C.F.R. § 41.37 for consideration by the Board of Patent Appeals and Interferences.

In the amended appeal brief, the “Status of Claims” section has been updated to provide a statement of the status of all claims as requested in the Notification of Non-Compliant Appeal Brief.

Furthermore, the “Summary of Claimed Subject Matter” section has been updated to refer to the specification by paragraph number for independent claim 12 as requested in the Notification of Non-Compliant Appeal Brief.

Appellant has also taken this opportunity to correct typographical errors in the Table of Contents.

The Commissioner is hereby authorized to charge any additional fees, and credit any over payments to Deposit Account No. 501593, in the name of Borden Ladner Gervais LLP. A duplicate copy of the Fee Transmittal is enclosed for this purpose.

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I. REAL PARTY IN INTEREST

The real party in interest is the assignee, Research In Motion Limited.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to the appellant, the appellant's legal representative, or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1, 2, 6-14 and 17-23 are pending. Claims 3-5 and 16 were cancelled during prosecution.

Claims 21 and 22 are rejected under 35 U.S.C. 102(a) as being anticipated by Christal, DE 10134830 A1 (referred to hereafter as Christal).

Claims 1, 2, 6-9, 11-14, 17-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christal in further view of Kim, KR 2002041098A (referred to hereafter as Kim).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christal and Kim as applied to claim 1 and further in view of Grivas et al, U.S. Patent Publication No. 2004/0116161 A1 (referred to hereafter as Grivas).

Rejections against all pending claims, i.e., claims 1,2, 6-14, and 17-23 are being appealed.

IV. STATUS OF AMENDMENTS

No Claim Amendments were made after the final rejection dated December 13, 2007.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claims of the present application provide for releasably retaining a peripheral device so that a charging port of a mobile device retained in a sleeve is in direct physical and electrical contact with an integral charging contact extending from the peripheral device to allow the mobile device to charge a battery in the peripheral device through the charging contact. The direct physical and electrical contact permits direct charging of the peripheral device from the mobile device, without intermediary electrical connections. Thus, compactness and portability are provided along with a long-lasting power supply for extended use between charging by connection to an external source.

Claim 21

We will start our summary of independent claims with claim 21.

Independent claim 21 is directed to a peripheral device for wireless communication with a mobile device, and is reproduced below with a mapping to portions of the specification and/or figures which describe embodiments of the invention (and thus the mapping should not be considered limiting, but is illustrative only):

21. A peripheral device (see for example element 34 in Figures 4A-4C, 5A-5B, 10 and 11), for wireless communication with a mobile device (see for example, element 28 in Figures 4A-4C, 5A-5B, 10 and 11), the peripheral device including:
 - a battery for receiving and storing a charge (see for example, paragraph [0015] of the original specification); and
 - an integral charging contact (see for example element 42 in 4A-4C, 5A-5B, 10 and 11) for providing a charge to the battery when placed in direct physical and electrical contact with a charging port (see for example element 32 in Figures 4A-4C, 5A-5B, 10 and 11) of the mobile device so as to permit the mobile device to charge the battery in the peripheral device.

Claim 1

Claim 1 is directed to a holster and is reproduced below with a mapping to portions of the specification and/or figures which describe embodiments of the invention (and thus the mapping should not be considered limiting, but is illustrative only):

1. A holster (see for example element 20 in Figures 4A-4C, 5A-5B, 10 and 11) for receiving and retaining a mobile device (see for example element 28 in Figures 4A-4C, 5A-5B, 10 and 11)

and a peripheral device (see for example element 34 in Figures 4A-4C, 5A-5C, 10 and 11), the holster comprising:

a sleeve (see for example paragraph [0026] of the original specification) for retaining the mobile device,
a mating structure (see for example element 24 in Figures 4A-4C, 5A-5B, 10 and 11) for releasably retaining (see for example paragraph [0027] of the original specification) the peripheral device such that a charging contact (see for example element 42 in Figures 4A-4C, 5A-5B, 10 and 11) integral with the peripheral device is in direct physical and electrical contact with the mobile device retained in the sleeve so as to permit the mobile device to charge a battery in the peripheral device through the charging contact of the peripheral device.

Claim 11

Claim 11 is directed to a holster and is reproduced below with a mapping to portions of the specification and/or figures which describe embodiments of the invention (and thus the mapping should not be considered limiting, but is illustrative only):

11. A holster (see for example element 20 in Figures 4A-4C, 5A-5B, 10 and 11) for receiving and retaining both a peripheral device (see for example element 34 in Figures 4A-4C, 5A-5B, 10 and 11) and a mobile device (see for example element 28 in Figures 4A-4C, 5A-5B, 10 and 11), the mobile device being retained in a sleeve, the holster comprising:

a mating structure (see for example element 24 in Figures 4A-4C, 5A-5B, 10 and 11) for releasably retaining (see for example paragraph [0027] of the original specification) the peripheral device in direct physical and electrical contact with the mobile device when retained in the sleeve so as to permit the mobile device to charge a battery in the peripheral device.

Claim 12

Claim 12 is directed to a system for mobile communications and is reproduced below with a mapping to portions of the specification and/or figures which describe embodiments of the invention (and thus the mapping should not be considered limiting, but is illustrative only):

A system for mobile communications comprising:

a mobile device (see for example element 28 in Figures 4A-4C, 5A-5B, 10 and 11), for connecting to a network providing voice services, having a charging port (see for example element 32 in Figures 4A-4C, 5A-5B, 10 and 11);

a peripheral device (see for example element 34 in Figures 4A-4C, 5A-5B, 10 and 11) for wireless communication with the mobile device, the peripheral device having both a battery and an integral charging contact (see for example element 42 in Figures 4A-4C, 5A-5B, 10 and 11); and

a holster (see for example element 20 in Figures 4A-4C, 5A-5B, 10 and 11) for receiving and retaining both the peripheral device and the mobile device so that the charging port and charging contact are in direct physical and electrical contact so as to allow the mobile device to charge the battery of the peripheral device (see for example paragraph [0015] of the original specification).

Independent claims 21, 1, 11, and 12 can best be understood by reference to embodiments of the invention as illustrated in Diagrams 1-4 (which are Figures 4A-4c, 5A-5B, 10 and 11 of the present application). The description with respect to Figures 4A-4C, 5A-5B, 10 and 11 are reproduced below from paragraphs [0018]-[0019] and [0026]-[0027] from the original specification.

[0018] Figure 4A illustrates a side view of a peripheral device 34 and holster 20 retaining mobile device 28. Peripheral device 34 has two mating structure 35 and a charging contact 42. As shown in Figures 4B and 4C, mating structure 35 and charging

contact 42 are accessible from the front of peripheral device 34. Mating structures 35 and 24 are located so that they can connect. Charging contact 42 is positioned such that connecting mating structures 35 and 24 brings charging contact 42 in electrical contact with charging port 32.

[0019] Figures 5A and 5B provide side and top views of peripheral device 34 mated with holster 20 and held in electrical contact with mobile device 28. Holster 20 holds mobile device 28 in its sleeve as previously described. Peripheral device 34 uses its mating structures 35 to mate with mating structure 24 on holster 20. Upon connection of mating structure 24 with mating structure 35, charging contact 42 of peripheral device 34 is placed in electrical contact with charging port 32. This allows a direct electrical contact between peripheral device 34 and mobile device 28. Mobile device 28 using charger 30 and charging port 32, which in various embodiments may be integrated into a single element, provides an electrical current to peripheral device 34 through charging contact 42. This current is used to charge the battery of peripheral device 34. One skilled in the art will readily appreciate that there are a plurality of designs for a charging unit to allow one battery-powered device to charge another. As a result, charger 30 of the mobile device 28 is able to charge peripheral device 34, while peripheral device 34 is connected to holster 20.

[0026] FIG. 10 illustrates a side view of the holster 20 holding mobile device 28 in its sleeve such that charger 30 and charging port 32 are in alignment with aperture 36, and holster 20 is aligned with peripheral device 34 to allow peripheral device 34 to mate with the holster 20. To mate with holster 20 peripheral device 34 will engage mating structure 24 with its mating structure 35 to provide a physical connection between holster 20 and peripheral device 34. Additionally, arm 40 is in

an exposed position such that a tongue 37 can be inserted into aperture 36 so that a charging contact 42 of peripheral device 34 is aligned to make contact with electrical contact 32 of mobile device 28.

[0027] FIG. 11 illustrates the engagement of peripheral device 34 with holster 20. Mating structures 24 and 35 provide a secure fastening of peripheral device 34 to holster 20. As described above, this attachment can be made using a number of known fasteners, including magnetic fastening. Charging contact 42 is in electrical contact with charging port 32 of mobile device 28 such that charger 30 can provide an electrical current to peripheral device 34 to recharge the batteries of the peripheral device. As discussed above, this provides a longer effective battery life for the peripheral device, while allowing the peripheral device 34 to carry a small capacity battery.

Dependent claims 2, 6-10, 13, 14, 17-20, 22, and 23 are involved in the appeal, but are not argued separately under the provisions of paragraph (c)(1)(vii) of 37 CFR 41.37.

Diagram 1

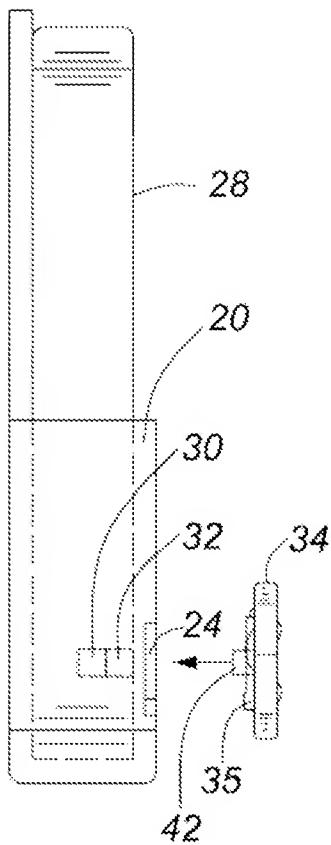


FIG. 4A

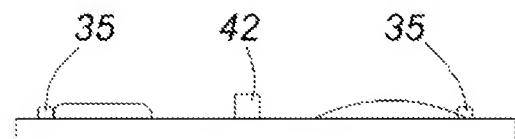


FIG. 4C

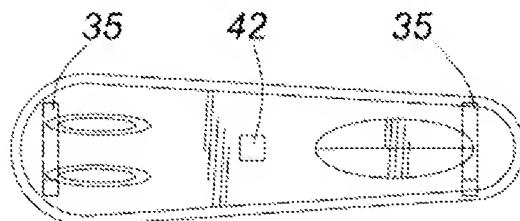


FIG. 4B

Diagram 2

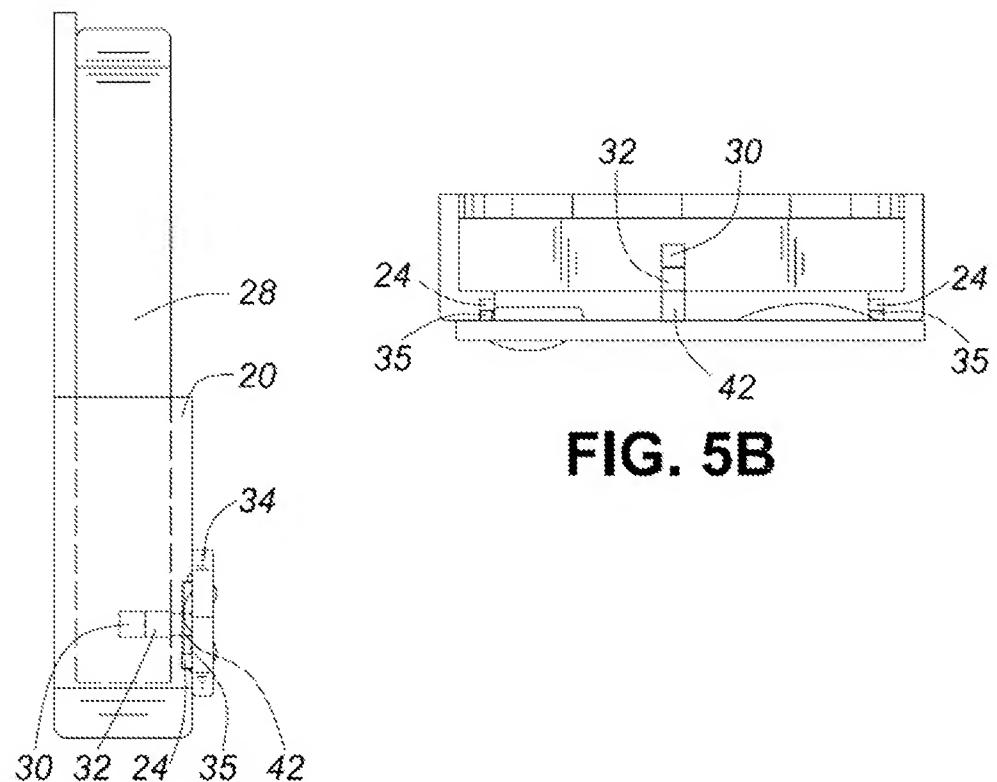


FIG. 5A

FIG. 5B

Diagram 3

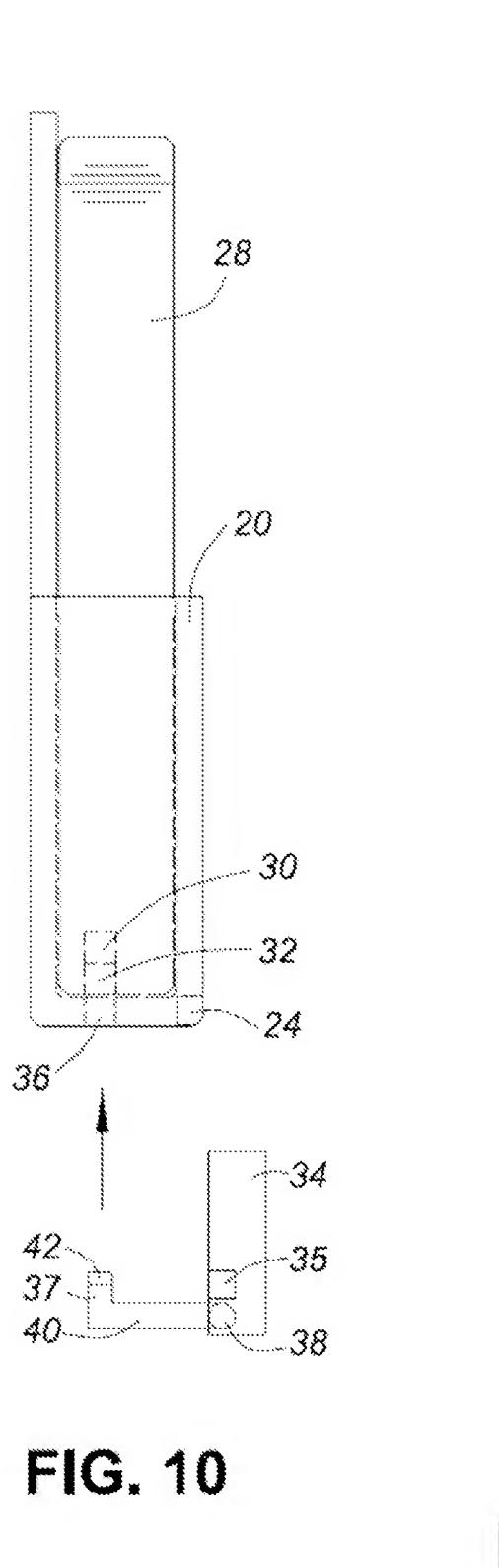


FIG. 10

Diagram 4

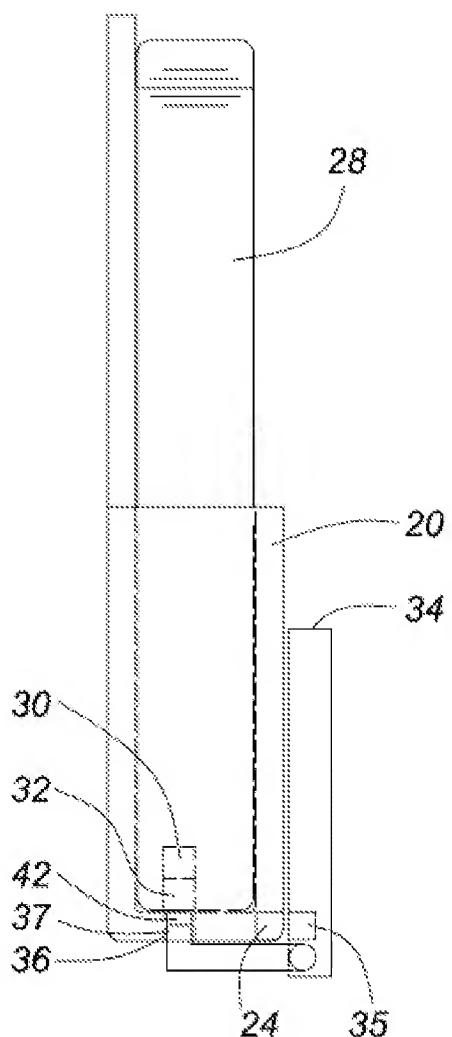


FIG. 11

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellant contends that all elements of claims 21 and 22 are not taught or suggested by Christal, and consequently the anticipation rejection under 35 U.S.C.102(a) to each of claims 21 and 22 should be withdrawn.

Appellant contends that all elements of claims 1, 2, 6-9, 11-14, 17-20 and 23 are not taught or suggested by Christal or Kim either alone or in combination, that all elements of claim 10 are not taught or suggested by Christal, Kim, and Grivas, and consequently the obviousness rejection under 35 U.S.C. 103(a) to each of claims 1, 2, 6-9, 10-14, 17-20 and 23 should be withdrawn.

Appellant contends that the Examiner has failed to consider the amendments and arguments presented in each of the Responses dated July 5, 2007, and November 21, 2007 and the submission dated February 25, 2008.

VII. ARGUMENTS

Rejections under 35 U.S.C.102(a)

The Examiner in the Final Action dated December 13, 2007, rejected claims 21 and 22 as being anticipated by Christal.

Claim 21

The Examiner stated with respect to claim 21, that Christal discloses: "A peripheral device (3) for wireless communication with a mobile device (2) (FIG2C), the peripheral device including: a battery for receiving and storing a charge (paragraph 30; FIG 1C, 2B, 2C); and a charging contact for providing a charge to the battery when placed in direct electrical contact with a charging port of a mobile device so as to permit the mobile to change the battery [*sic*] in the peripheral device (paragraphs 14, 30; FIG 1C, 2B, 2C)" (see Final Action dated December 13, 2007, at page 2).

Appellant argues that Christal fails to anticipate claim 21 as Christal fails to teach each element of claim 21.

The Court of Appeals for the Federal Circuit has stated that “[t]o anticipate, every *element and limitation* of the claimed invention must be found in a single prior art reference, *arranged as in the claim.*” (*Brown v. 3M*, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) citing *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991) (Emphasis added). The Federal circuit has added that the anticipation determination is viewed from one of ordinary skill in the art: “There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” (*Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).)

Appellant submits that Cristal fails to teach or suggest at least “an integral charging contact for providing a charge to the battery when placed in direct physical and electrical contact with a charging port of the mobile device so as to permit the mobile device to charge the battery in the peripheral device” as recited in claim 21 (emphasis added).

Appellant submits that the Examiner has omitted the feature that the peripheral device includes an “integral” charging contact as recited in claim 21 when mapping the elements recited in the claim to the cited prior art reference.

The rejection to the claim 21 relies on Figures 1C, 2B, 2C, plus the description at paragraphs 14 and 30 of Christal. Christal teaches the use of intermediary electrical conductors (see for example, elements 1 and 19 of Christal) for electrical contact of the mobile device with the peripheral device. Thus, the mobile device and the peripheral device are not in direct physical contact with each other. Furthermore, the electrical contacts shown in Figure 2C, a portion of which is shown in Figure 2B, are clearly part of the holding device and are not part of the peripheral device. This is clear from the description of, for example, Figure 2B which clearly states “in the Fig. 2b has represented this holding device without the mobile telephone 2 and without the microphone headphone unit 3”. Figure 2B, however, clearly shows the electrical contact 14, which forms part of the electrical conductors 19. Similarly, the electrical contacts 14 and 15 of the “distance piece” described in the application are part of the bag 4, as disclosed in paragraph [0031] which discloses that “distance piece 1 is in or at the bag 4”.

Thus, the electrical conductors shown in the Christal are clearly not part of the peripheral device for wireless communication with the mobile device. It is therefore believed that the Christal reference cannot possibly anticipate claim 21 of the present application, which requires that the peripheral device include an integral charging contact for providing a charge to the battery when placed in direct physical and electrical contact with a charging port of the mobile device.

Moreover, the Examiner admits that “Christal fails to disclose to permit the mobile device to charge a battery in the peripheral device through a charging contact extending from the peripheral device” (see Final Action dated December 13, 2007, at pages 3-4, emphasis added). Therefore, if Christal fails to disclose a mobile device to charge a peripheral device through a charging contact extending from the peripheral device, it clearly follows that Christal cannot teach or suggest a peripheral device including a battery and “an integral charging contact for providing a charge to the battery when placed in direct physical and electrical contact with a charging port of the mobile device so as to permit the mobile device to charge the battery in the peripheral device” as recited in claim 21.

Clearly, Christal does not teach or suggest all the elements of claim 21.

Claim 22 includes all the elements of independent claim 21 and, accordingly, it is believed that this claim also fully distinguishes over Christal.

Thus, for at least the reasons stated above, Appellant contends that all elements of claims 21 and 22 are not taught or suggested by Christal, and consequently the anticipation rejection under 35 U.S.C.102(a) to each of claims 21 and 22 should be withdrawn.

Rejections under 35 U.S.C.103(a)

The Examiner rejected claims 1, 2, 6-9, 11-14, 17-20 and 23 as being unpatentable over Christal in further view of Kim. The Examiner also rejected claim 10 as being unpatentable over Christal and Kim as applied to claim 1 and further in view of Grivas. Each of the independent claims 1, 11 and 12 will be separately considered below. Dependent claims 2, 6-10, 13, 14, 17-20, 22, and 23 are involved in the appeal, but are not argued separately under this section.

Claim 1

Appellant contends that Christal and Kim, either alone or in combination, do not teach or suggest all the elements of claim 1.

As described in section V of this brief, claim 1 recites, among others, “a charging contact integral with the peripheral device is in direct physical and electrical contact with the mobile device retained in the sleeve so as to permit the mobile device to charge a battery in the peripheral device through the charging contact of the peripheral device” (emphasis added).

Thus, it is clear from claim 1 that the charging contact is part of the peripheral device (integral with) and the charging contact (that is part of the peripheral device) is in direct physical and electrical contact with the mobile device retained in the sleeve so as to permit the mobile device to charge a battery in the peripheral device through the charging contact of the peripheral device. Thus, the peripheral device is in direct physical and electrical contact with the mobile device.

As indicated above with respect to claim 21, the Christal reference teaches that the charging contacts of the peripheral device are connected to electrical contacts of the mobile device only through intermediary electrical conductors of the holding device. Thus, there is no teaching or suggestion, in Christal, of a charging contact that is integral with the peripheral device being in direct physical and electrical contact with the mobile device.

The Examiner alleges that Christal discloses “a mating structure (2B, 2C) for releasably retaining the peripheral device such that a charging contact of the peripheral device (paragraph 14) is in direct physical and (19) electrical contact with the mobile device retained in the sleeve (see paragraphs 10, 28, and 32-33)” (see Final Action dated December 13, 2007 at page 3).

However, once again, the Examiner has omitted the feature that the “charging contact [is] integral with the peripheral device” as recited in claim 1 (emphasis added) when mapping the elements recited in the claim to the cited prior art reference.

Thus, clearly, Christal fails to teach or suggest all the features of claim 12.

Furthermore, the Examiner admits that “Christal fails to disclose to permit the mobile device to charge a battery in the peripheral device through a charging contact extending from the peripheral device” (see Final Action dated December 13, 2007, at pages 3-4, emphasis added). The Examiner contends that this feature was old and well known in the art at the time of invention as taught by Kim.

Appellant argues that Kim does not teach or suggest “a charging contact integral with the peripheral device is in direct physical and electrical contact with the mobile device retained in the sleeve so as to permit the mobile device to charge a battery in the peripheral device through the charging contact of the peripheral device” as recited in claim 1 (emphasis added).

Kim teaches the use of an intermediary connector such as a cable having a jack for attaching a cellular phone and a cordless headset. While Kim teaches the use of such a connector for charging the battery in the peripheral device from the battery of the mobile device, Kim fails to teach or suggest a charging contact integral with the peripheral device of the peripheral device being in direct physical and electrical contact with the mobile device. Instead, an intermediary connector is required.

Thus, neither of the cited prior art references teach or suggest a mating structure for releasably retaining the peripheral device such that a charging contact that is integral with the peripheral device (or part of the peripheral device) is in direct physical and electrical contact with the mobile device as recited in claim 1.

On the contrary, both prior art references teach the use of intermediary conductors. Further still, there is no direct physical contact between any part of the peripheral device and the mobile device in either of the cited references.

Based on the foregoing, it is submitted that there is no possibility of combining the prior art references to arrive at the present invention as claimed in independent claim 1. Moreover, the Examiner’s proposed modification of Christal’s holster to accommodate the intermediary connector of Kim so as to arrive at the holster as claimed in claim 1 still does not include “a charging contact integral with the peripheral device [that] is in direct physical and electrical

contact with the mobile device retained in the sleeve so as to permit the mobile device to charge a battery in the peripheral device through the charging contact of the peripheral device" (emphasis added). Thus, Christal and Kim, either alone or in combination, do not teach or suggest all the elements of claim 1 and hence, the Examiner has failed to establish a *prima facie* case of obviousness (MPEP §§ 706.02(j)).

Claims 2, 6-9 and 20 include all the elements of independent claim 1 and, accordingly, for at least the reasons stated above, Christal and Kim, either alone or in combination, do not teach or suggest all the elements of these claims.

The Examiner rejected claim 10 as being unpatentable over Christal and Kim as applied to claim 1 and further in view of Grivas. As indicated above, the Christal and Kim references fail to teach or suggest "a mating structure for releasably retaining the peripheral device such that a charging contact integral with the peripheral device is in direct physical and electrical contact with the mobile device" as recited in claim 1. The Grivas reference fails to cure the deficiencies of the Christal and Kim references. In particular, the Grivas reference teaches the use of an intermediary connector between a camera peripheral device and a mobile device, as clearly shown in Figure 1. It is therefore submitted that the claim 10 fully distinguishes over the cited Grivas reference when taken alone and when combined with the cited Christal and Kim references.

Thus, Appellant contends that all elements of claims 1, 2, 6-9 and 20 are not taught or suggested by Christal and Kim, either alone or in combination; that all elements of claim 10 are not taught or suggested by Grivas alone or in combination with Christal and Kim; and consequently the obviousness rejections under 35 U.S.C.103(a) to each of claims 1, 2, 6-10, and 20 should be withdrawn.

Claim 11

Appellant contends that Christal and Kim, either alone or in combination, do not teach or suggest all the elements of claim 11.

As described in section V of this brief, claim 11 recites, among others, “a mating structure for releasably retaining the peripheral device in direct physical and electrical contact with the mobile device when retained in the sleeve so as to permit the mobile device to charge a battery in the peripheral device” (emphasis added).

The Examiner asserts that Christal discloses “a mating structure (2B, 2C) for releasably retaining the peripheral device in direct (19) electrical contact with the mobile device when retained in the sleeve (paragraphs 28, and 32-33)” (see Final Action dated December 13, 2007 at page 6).

Yet again, the Examiner has omitted the feature that the “the peripheral device [is] in direct physical and electrical contact with the mobile device” as recited in claim 11 (emphasis added) when mapping the elements recited in the claim to the cited prior art reference.

Appellant reiterates the arguments presented above with respect to claim 21, and submits that the Christal reference teaches that the charging contacts of the peripheral device are connected to electrical contacts of the mobile device only through intermediary electrical conductors of the holding device. Thus, there is no teaching or suggestion, in Christal, of a charging contact that is integral with the peripheral device being in direct physical and electrical contact with the mobile device.

Moreover, the cited passages of Christal (paragraphs 32-33) simply do not support the Examiner’s allegation that Christal teaches the headset is in direct physical and electrical contact with the mobile device. These paragraphs of the cited reference teach the use of a “distance piece” as an intermediary between the mobile device and headset. Referring to Figure 1 of the cited reference, the headset sits in a front pocket while the mobile phone is placed in the larger pocket (9). The two devices are connected by the intermediary distance piece (1) that is part of or in the bag (4). Similarly, Figure 2 shows a headset mounted to a device that includes the intermediary conductor 19. The mobile phone also mounts to the

same device, adjacent the headset, as best shown in Figure 2A. Neither the Figures nor the associated description teaches or suggests the two devices in direct physical and electrical contact, as recited in claim 11.

Nothing in Kim cures the deficiencies of Christal noted above. In fact, as submitted with respect to claim 11, Kim teaches the use of an intermediary connector such as a cable having a jack for attaching a cellular phone and a cordless headset. While Kim teaches the use of such a connector for charging the battery in the peripheral device from the battery of the mobile device, Kim fails to teach or suggest a charging contact integral with the peripheral device of the peripheral device being in direct physical and electrical contact with the mobile device. Instead, Kim requires the use of an intermediary connector.

Thus, Christal and Kim, either alone or in combination, do not teach or suggest all the elements of claim 11 and hence, the Examiner has failed to establish a prima facie case of obviousness (MPEP §§ 706.02(j)).

Thus, Appellant contends that all elements of claim 11 are not taught or suggested by Christal and Kim, either alone or in combination, and consequently the obviousness rejections under 35 U.S.C.103(a) to claim 11 should be withdrawn.

Claim 12

Appellant contends that Christal and Kim, either alone or in combination, do not teach or suggest all the elements of claim 12.

As described in section V of this brief, claim 12 recites, among others, “a peripheral device for wireless communication with the mobile device, the peripheral device having both a battery and an integral charging contact” and “the charging port and charging contact are in direct physical and electrical contact so as to allow the mobile device to charge the battery of the peripheral device” (emphasis added).

The Examiner alleges that Christal teaches “a peripheral device (3) for wireless communication with the mobile device, the peripheral device having both a battery and a charging contact (paragraph 30); and a holster (11,8) for receiving and retaining both the

peripheral device and the mobile device so that the charging port and charging contact are in direct electrical contact (FIG 1A, 2A, 2C; paragraphs 28, and 32-33)" (see Final Action dated December 13, 2007 at page 7).

Again, the Examiner has omitted the feature that "the peripheral device [has] both a battery and an integral charging contact" and the feature that "charging port and charging contact are in direct physical and electrical contact" as recited in claim 12 (emphasis added) when mapping the elements recited in the claim to the cited prior art reference.

As is evident, Christal teaches the peripheral device connected to the mobile device only through intermediary electrical conductors (with associated intermediary contacts) of the holding device. There is absolutely no teaching or suggestion of a charging contact that is integral with the peripheral device being in direct physical and electrical contact with the mobile device.

Thus, clearly, Christal fails to teach or suggest all the features of claim 12.

In addition, the Examiner admits that "Christal fails to disclose to allow the mobile device to charge a battery in the peripheral device" (see Final Action dated December 13, 2007, at page 7, emphasis added). The Examiner contends that this feature was old and well known in the art at the time of invention as taught by Kim.

However, Appellant argues that Kim does not teach or suggest "a peripheral device for wireless communication with the mobile device, the peripheral device having both a battery and an integral charging contact" and "the charging port and charging contact are in direct physical and electrical contact so as to allow the mobile device to charge the battery of the peripheral device" as recited in claim 12 (emphasis added).

Appellant reiterates the earlier submissions with respect to Kim and argues that Kim teaches the use of an intermediary connector such as a cable having a jack for attaching a cellular phone and a cordless headset. Kim fails to teach or suggest a charging contact that is integral with the peripheral device being in direct physical and electrical contact with the mobile device. Instead, the intermediary connector is used.

Therefore, Kim fails to cure the deficiencies of Christal as Kim clearly teaches the use of a separate connector for connecting the cellular phone with the cordless headset.

Based on the foregoing, it is submitted that there is no possibility of combining the prior art references to arrive at the present invention as claimed in independent claim 12. Moreover, the Examiner's proposed modification of Christal's holster to accommodate the intermediary connector of Kim so as to arrive at the holster as claimed in claim 12 still does not include "the peripheral device having both a battery and an integral charging contact" and "the charging port and charging contact are in direct physical and electrical contact" so as to allow the mobile device to charge the battery of the peripheral device" (emphasis added). Thus, Christal and Kim, either alone or in combination, do not teach or suggest all the elements of claim 12 and hence, the Examiner has failed to establish a prima facie case of obviousness (MPEP §§ 706.02(j)).

Claims 13, 14 and 17-19 include all the elements of independent claim 12 and, accordingly, for at least the reasons stated above, Christal and Kim, either alone or in combination, do not teach or suggest all the elements of these claims.

Thus, Appellant contends that all elements of claims 12-14 and 17-19 are not taught or suggested by Christal and Kim, either alone or in combination and consequently the obviousness rejections under 35 U.S.C.103(a) to each of claims 12-14, and 17-19 should be withdrawn.

Failure to Consider Applicant's Amendments and Arguments

Appellant contends that the Examiner has failed to consider the amendments and arguments presented in each of the Responses dated July 5, 2007, and November 21, 2007 and the submission dated February 25, 2008.

In accordance with MPEP 2145 CONSIDERATION OF APPLICANT'S REBUTTAL ARGUMENTS, the "Office personnel should consider all rebuttal arguments and evidence presented by applicants". Also, in accordance with MPEP 706.07 FINAL REJECTION, the

Final Action “should include a rebuttal of any arguments raised in the applicant’s reply”.

Appellant contends that the Examiner has failed on both counts as set forth below.

Independent claims 1, 11, 12 and 21 were amended in the Response dated July 5, 2007 to further clarify and point out and distinctly claim the subject matter, which the applicant regarded as the invention.

Specifically, Claim 1 was amended to particularly recite “a mating structure for releasably retaining the peripheral device such that a charging contact of the peripheral device is in direct physical and electrical contact with the mobile device retained in the sleeve” (emphasis added).

Independent claim 11 was similarly amended to recite “a mating structure for releasably retaining the peripheral device in direct physical and electrical contact with the mobile device when retained in the sleeve” (emphasis added).

Claim 12 was amended to similarly recite “the charging port and charging contact are in direct physical and electrical contact so as to allow the mobile device to charge the battery of the peripheral device” (emphasis added).

Independent Claim 21 was also amended to recite, “a charging contact for providing a charge to the battery when placed in direct physical and electrical contact with a charging port of the mobile device” (emphasis added).

The Examiner indicated, in the Advisory Action dated July 17, 2007, that “the amendment claims [sic] would require further search and consideration” (see Advisory Action dated July 17, 2007, at continuation sheet).

A Request for Continued Examination was filed on August 16, 2007. Subsequently, the Examiner issued a non-final Office Action on August 23, 2007. Appellant submits that the Examiner did not fully consider the amendments and/or the remarks made in the Response dated July 5, 2007 and simply maintained all the rejections from the previous Final Action dated May 17, 2007 in the non-final Office Action dated August 23, 2007.

Specifically, with respect to claim 21, the Examiner alleged, in the Final Action dated May 17, 2007, that Christal discloses “a charging contact for providing a charge to the battery when placed in direct electrical contact with a charging port of a mobile device **so as to permit the mobile to change [sic] the battery in the peripheral device** (paragraphs 14, 30; FIG 1C, 2B, 2C)” (see Final Action dated May 17, 2007 at page 2, emphasis in original).

Compare this with the Examiner’s allegation in the non-final Office Action dated August 23, 2007, with respect to claim 21 based on Christal: “a charging contact for providing a charge to the battery when placed in direct electrical contact with a charging port of a mobile device so as to permit the mobile to change [sic] the battery in the peripheral device (paragraphs 14, 30; FIG 1C, 2B, 2C)” (see non-final Office Action dated August 23, 2007 at page 3).

As is evident, the Examiner appears to have completely ignored the amendment made to claim 21 in the Response dated July 5, 2007, and appears to have simply “cut and paste” the rejections with respect to claim 21 to the extent of propagating the same typographical errors in the rejections.

Appellant submits that a comparison of the Examiner’s remarks under the section “Response to Arguments” in the Final Action dated May 17, 2007 and the non-final Action dated August 23, 2007, clearly shows that the Examiner has once again simply “cut and paste” the remarks with respect to the Applicant’s arguments to the extent of propagating the same typographical errors in the remarks. See, for example, “...the features of the present application (such as direct physical contact does not thought by the references” (Final Action dated May 17, 2007 at page 12 and non-final Office Action dated August 23, 2007, at page 11).

In fact, the remainder of the Examiner’s remarks under the section “Response to Arguments” in the Final Action dated May 17, 2007 and the non-final Action dated August 23, 2007, are also identical.

Notwithstanding the Examiner's failure to consider the amendments and remarks presented in the Response dated July 5, 2007, Applicant responded to the non-final Action dated August 23, 2007, with further clarifying amendments and provided additional arguments in support of the patentability of the claims in the Response dated November 21, 2007.

Specifically, independent claims 1, 12, and 21 were amended in the Response dated November 21, 2007.

Claim 1 was amended to particularly recite "a mating structure for releasably retaining the peripheral device such that a charging contact integral with the peripheral device is in direct physical and electrical contact with the mobile device retained in the sleeve" (emphasis added).

Claim 12 was amended to recite "a peripheral device for wireless communication with the mobile device, the peripheral device having both a battery and an integral charging contact" (emphasis added).

Independent Claim 21 was also amended to recite that the peripheral device includes "an integral charging contact for providing a charge to the battery when placed in direct physical and electrical contact with a charging port of the mobile device" (emphasis added).

The Examiner issued a Final Action on December 13, 2007. Appellant submits that the Examiner did not fully consider the amendments and/or the remarks made in the Response dated November 21, 2007 and simply maintained all the rejections from the previous non-final Action Office Action dated August 23, 2007, which as established earlier, was identical to Final Action dated May 17, 2007.

For example, at page 2 of the Final Action dated December 13, 2007, the Examiner alleges, with respect to claim 21, that Christal discloses, "a charging contact for providing a charge to the battery when placed in direct electrical contact with a charging port of a mobile device so as to permit the mobile to change *[sic]* the battery in the peripheral device (paragraphs 14, 30; FIG 1C, 2B, 2C)."

As is evident, the Examiner appears to have entirely ignored the amendment made to claim 21 in the Response dated November 21, 2007, and appears to have simply “cut and paste” the rejections with respect to claim 21 to the extent of propagating the same typographical errors in the rejections.

In fact, as with the non-final Office Action dated August 23, 2007, the Examiner’s remarks under the section “Response to Arguments” in the Final Action dated December 13, 2007 are identical to the corresponding sections of the non-final Action dated August 23, 2007, which as established earlier, were identical to Final Action dated May 17, 2007.

Appellant submits that the Examiner has similarly failed to consider the amendments made to independent claims 1, 11, and 12 in the Response dated July 5, 2007, and the amendments made to independent claims 1 and 12 in the Response dated November 21, 2007, along with arguments presented in support of the patentability of the claims.

Appellant also made a Submission After Final Action on February 25, 2008, stating that “it is believed that the Final Action issued December 13, 2007 included an error in responding to Applicant’s Arguments made in the Response dated November 21, 2007.”

For the Board’s convenience, the submission dated February 25, 2008, is reproduced below:

The undersigned wishes to thank Examiner Mehrpour for her time in discussing the Final Office Action issued December 13, 2007 in relation to the above-noted application. In our telephone conversation of February 21, 2008, the undersigned explained that it is believed that there was an inadvertent error in this Office Action. More particularly, in the Response to Arguments, it appears that the comments are repeated from a previous Office Action and do not address the Applicant's arguments made in the response dated November 21, 2007. The Examiner requested that the undersigned make a paper submission explaining the facts and requesting that a corrected Action be issued.

As indicated, it is believed that the Final Action issued December 13, 2007 included an error in responding to Applicant's Arguments made in the response dated November 21, 2007.

For example, it is stated "In response to the applicant's argument that "Christal and Kim fails to teach a mating structure for releasably retaining the peripheral device in direct electrical contact with the mobile device when retained in the sleeve so as to permit the mobile to charge a battery in the peripheral and the features of the present application (such as direct physical contact) does not thought by the references" and a response is provided beginning at page 11 of the Final Action. This section, as quoted, is not found anywhere in applicant's response of November 21, 2007, or in Applicant's response dated July 5, 2007, however.

In another example it is stated "In response to applicant's argument that there is no suggestion to combine the references..." and a response is provided at page 12 of the Final Action. Applicant, however, did not present the argument referred to by the Examiner in Applicant's response of November 21, 2007 or in Applicant's response dated July 5, 2007.

It is believed that the response provided is not responsive to Applicant's clarifying amendments and arguments made in an effort to advance prosecution.

The Applicant respectfully requests the Examiner's reconsideration and, as discussed, issuance of a corrected Office Action, if the Examiner deems it necessary.

Appellant's representative followed up this submission with a telephone interview with the Examiner on March 4, 2008 and filed an interview summary on March 12, 2008. For the Board's convenience, the submission dated March 12, 2008, is reproduced below:

The undersigned followed up with the Examiner by telephone call on March 4, 2008 to determine if Examiner Mehrpour had a chance to review Applicant's submission of February 25, 2008 and if a further response by the applicant in advance of the March 13, 2008 deadline for responding to the Final Action dated December 13, 2007 is necessary. The undersigned was advised that no further response should be filed and that the Examiner would respond to Applicant's submission of February 25, 2008.

Following these submissions, the Examiner issued an Advisory Action dated April 1, 2008. The Examiner's statement in support for the conclusion that the submission dated February 25, 2008 did not place the application in condition for allowance, was nothing but a verbatim copy of the Examiner's remarks under the section "Response to Arguments" in the Final Action dated December 13, 2007, which as established earlier are identical to the corresponding sections of the non-final Action dated August 23, 2007 and the Final Action dated May 17, 2007.

Appellant respectfully submits that the Examiner has not provided sufficient basis on which to maintain the rejections set forth in the Final Action dated December 13, 2007. In accordance with MPEP 706.07 FINAL REJECTION, the Final Action "should include a rebuttal of any arguments raised in the applicant's reply".

Furthermore, in accordance with MPEP 2145 CONSIDERATION OF APPLICANT'S REBUTTAL ARGUMENTS, the "Office personnel should consider all rebuttal arguments and evidence presented by applicants".

VIII. CONCLUSION

Applicant respectfully requests that the Board enter a decision overturning the Examiner's rejection of all pending claims, and holding that the claims are not anticipated and are not rendered obvious by the prior art.

Respectfully submitted,

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IX. CLAIMS APPENDIX

1. (Previously presented) A holster for receiving and retaining a mobile device and a peripheral device, the holster comprising:
 - a sleeve for retaining the mobile device,
 - a mating structure for releasably retaining the peripheral device such that a charging contact integral with the peripheral device is in direct physical and electrical contact with the mobile device retained in the sleeve so as to permit the mobile device to charge a battery in the peripheral device through the charging contact of the peripheral device.
2. (Previously presented) The holster of claim 1, wherein the holster mating structure connects with a peripheral device mating structure to releasably retain the peripheral device so that a charging port of the mobile device is in direct physical and electrical contact with the charging contact of the peripheral device to allow the mobile device to charge the battery in the peripheral device.
3. (Cancelled)
4. (Cancelled)
5. (Cancelled)
6. (Previously presented) The holster of claim 2, further including a base for supporting the mobile device in the sleeve, the base having an aperture for receiving the charging contact and allowing it to make direct electrical contact with the charging port.
7. (Previously presented) The holster of claim 1, wherein the holster mating structure is selected from the group consisting of a retaining bracket, a magnet, a tab, a latch, a flange, a hook, a clamp, a friction fit, and a tongue and groove.
8. (Original) The holster of claim 1, wherein the mobile device is a cellular phone and the peripheral device is a wireless headset for interaction with the mobile phone.
9. (Previously presented) The holster of claim 1, wherein the mobile device communicates with the peripheral device on a Bluetooth communication channel.

10. (Original) The holster of claim 1, wherein the mobile device is a cellular phone and the peripheral device is a camera for interaction with the mobile phone

11. (Previously presented) A holster for receiving and retaining both a peripheral device and a mobile device, the mobile device being retained in a sleeve, the holster comprising:

a mating structure for releasably retaining the peripheral device in direct physical and electrical contact with the mobile device when retained in the sleeve so as to permit the mobile device to charge a battery in the peripheral device.

12. (Previously presented) A system for mobile communications comprising:

a mobile device, for connecting to a network providing voice services, having a charging port;

a peripheral device for wireless communication with the mobile device, the peripheral device having both a battery and an integral charging contact; and

a holster for receiving and retaining both the peripheral device and the mobile device so that the charging port and charging contact are in direct physical and electrical contact so as to allow the mobile device to charge the battery of the peripheral device.

13. (Previously presented) The system of claim 12, wherein the holster includes a sleeve for releasably retaining the mobile device.

14. (Previously presented) The system of claim 12, wherein the holster includes a mating structure for releasably retaining the peripheral device such that the charging contact and the charging port are in direct physical and electrical contact when both the mobile device and the peripheral device are retained in the holster.

15. (Cancelled)

16. (Cancelled)

17. (Previously presented) The system of claim 12, wherein the mobile device or the peripheral device includes a controller for regulating charging.

18. (Previously presented) The system of claim 13 wherein the holster further includes a base for supporting the mobile device in the sleeve, the base having an aperture for

receiving the charging contact and allowing it to make direct electrical contact with the charging port.

19. (Previously presented) The holster of claim 14, wherein the mating structure is selected from the group consisting of a retaining bracket, a magnet, a tab, a latch, a flange, a hook, a clamp, a friction fit, and a tongue and groove.

20. (Previously presented) The holster of claim 1, wherein the mobile device is a cellular phone and the peripheral device is selected from a group including a wireless headset for interaction with the cellular phone, a wireless headset for interaction with the cellular phone over a Bluetooth communication channel, and a camera for interaction with the mobile phone.

21. (Previously presented) A peripheral device for wireless communication with a mobile device, the peripheral device including:

a battery for receiving and storing a charge; and

an integral charging contact for providing a charge to the battery when placed in direct physical and electrical contact with a charging port of the mobile device so as to permit the mobile device to charge the battery in the peripheral device.

22. (Previously presented) The peripheral device of claim 21, wherein the peripheral device is a headset.

23. (Previously presented) The system of claim 14 wherein the holster mating structure and the charging port of the mobile device cooperate with a peripheral device mating structure and the charging contact of the peripheral device to releasably retain the peripheral device.

X. EVIDENCE APPENDIX

None

XI. RELATED PROCEEDINGS APPENDIX

None